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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,056	09/29/2003	Georges R. Harik	Google-38 (GP-100-00-US)	1182
26479	7590	07/17/2006	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			PADMANABHAN, KAVITA	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/674,056

Applicant(s)

HARIK, GEORGES R.

Examiner

Kavita Padmanabhan

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.  
4a) Of the above claim(s) 7-28 and 35-56 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6 and 29-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/8/05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-56 are pending.
2. Claims 7-28 and 35-56 have been withdrawn.
3. Claims 1-6 and 29-34 are rejected.

### ***Election/Restrictions***

4. Applicant's election with traverse of Group I, claims 1-6 and 29-34, in the reply filed on 4/20/06 is acknowledged. The traversal is on the ground(s) that all of the claims are directed to generating information for an online advertisement and therefore would be classified in the same class and subclass and that the sub-combinations have not been properly shown to be useable together because they overlap partially in scope. This is not found persuasive for reasons of record. To clarify, although the claims may all relate generally to online advertisements, the limitations of the different inventions claimed would cause them to be classified separately and would certainly require separate searches. Furthermore, even if certain limitations of inventions appear to overlap, that does not mean that the inventions as a whole overlap in scope. The distinct inventions identified by the examiner are indeed subcombinations useable together in that the inventions as a whole do not overlap in scope and at least one subcombination identified, namely Group I, is separately useable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at page 5, line 10. Applicant is required to delete this and other such embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 4 and 32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 4 and 32** each recite the limitation "ad creative" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

The examiner will apply prior art to these claims as best understood, giving the claim language its broadest reasonable interpretation, in light of the above rejections.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-5 and 29-33** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **Claims 1-5** recite a method but the method claimed does not appear to produce a useful, concrete and tangible result.

For example, **claim 1** results in a determination being made. This is merely an abstract idea and does not conclude in a tangible result. **Claims 2-5** are similarly nonstatutory. Claim 6 appears to overcome the deficiencies of claim 1 from which it depends.

**Claim 29** recites an apparatus comprising means for performing a method that is substantially the same as the method recited in claim 1. As a result, claims 29-33 are nonstatutory for the same reasons as claims 1-5 as explained above. Claim 34 appears to overcome the deficiencies of claim 29 from which it depends.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1-6 and 29-34** are rejected under 35 U.S.C. 102(e) as being anticipated by **Rorex et al.** (US 6,876,997, hereinafter “Rorex”).

In regards to **claim 1**, **Rorex** teaches a method for generating information for an online advertisement, the method comprising:

a) generating a search result using a search query and an index of advertiser Web page information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31**); and

b) determining at least one of (A) landing page information (**Rorex; col. 4, lines 33-46**) and (B) ad creative information using the search result.

**Claims 2-4** are rejected based on their dependency on claim 1. Claim 1 recites “determining at least one of landing page information and ad creative information,” and the reference teaches determining landing page information, whereas claims 2 and 3 seek to further limit the determination of ad creative information.

In regards to **claim 5**, **Rorex** teaches the method of claim 1 wherein the landing page information is a URL included in the search result (**Rorex; col. 5, lines 38-45**).

In regards to **claim 6**, **Rorex** teaches the method of claim 1 further comprising:

c) generating an ad using the determined at least one of a landing page information and ad creative information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – the**

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**search result listings are themselves ads that are used to advertise a particular advertiser's product to the user, which is why an advertiser pays for placement of their web page in the search result listings, because it serves as an advertisement to attract users to a particular advertiser's product); and**

d) generating a search result page including

i) at least one search result corresponding to the search query (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57**), and

ii) the generated ad (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57**).

**Claims 29-34** are rejected with the same rationale given for claims 1-6, respectively.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kavita Padmanabhan  
Assistant Examiner  
AU 2161

July 6, 2006

*K.P.*  
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**UYEN LE**  
**PRIMARY EXAMINER**